



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,564	07/20/2001	Michael C. Pelletier	SOM920010001US1	4357

23334 7590 11/18/2003

FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI
& BIANCO P.L.
ONE BOCA COMMERCE CENTER
551 NORTHWEST 77TH STREET, SUITE 111
BOCA RATON, FL 33487

EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,564

Applicant(s)

PELLETIER, MICHAEL C.

Examiner

Firmin Backer

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to a letter for patent filed on July 20th, 2001 in which claims 1-17 are presented for examination. Claims 1-17 are pending in the letter.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. .

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 1-8 only recites an abstract idea. The recited step determining a credit card address of an end user ... associating one or more pieces of

Art Unit: 3621

advertisement ... etc. does not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1-8 deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al (US PG Pub No. 2003/0023489.) in view of Yamada et al (U.S. PG Pub No. 2002/0049677).

5. As per claims 1, McGuire et al teach a method at an online store to target advertisement to be sent along with content (*see abstract, figs 1-5*), the method comprising determining a credit card clearing address (*determining and address*) of an end user device (*client computer*) using an address verification system (*see fig 24, paragraphs 0051-0053*) wherein an end user sends a request via the end user device for the delivery of content and associating one or more pieces of

Art Unit: 3621

advertisement with the content if the address verification system returns an address in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*). McGuire et al fail to teach an inventive concept wherein a user requests the delivery of encrypted digital content. However, Yamada et al teach an inventive concept wherein a user requests the delivery of encrypted digital content (*see paragraphs 0015, 0040, 0051, 0117*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McGuire et al's inventive concept to include Yamada et al's concept wherein a user request the delivery of encrypted digital content because this would have provided a method/system to specify each user who is entitled to the service the provider intends to provide, and prevent eavesdroppers from connecting themselves to the information transmission path and stealing service information (information steal protection).

6. As per claims 2, McGuire et al teach a method wherein the step of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see fig 24, paragraphs 0051-0053*).

7. As per claims 3, McGuire et al teach a method further comprising determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the step of associating the one or more pieces of advertisement includes associating

Art Unit: 3621

advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region or if the IP address of the end user device is in a predetermined geographic region (*see fig 24, paragraphs 0051-0053*).

8. As per claims 4, McGuire et al teach a method further comprising determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the step of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region and if the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*).

9. As per claims 5, McGuire et al teach a method wherein determining an IP address of the end user device includes at least one of the following sub-steps: querying one or more IP addresses in IP databases provided by third parties; checking one or more country codes found in the trace routes to the IP address being determined; and using preassigned country allocations for class C IP addresses (*see paragraphs 0047, 0049, 136-139*).

10. As per claims 6, McGuire et al teach a method wherein determining an IP address of the end user device includes computing a confidence for the IP address comprising the sub-steps of: querying the IP address; and checking one or more country codes found in the trace routes; wherein after the confidence of is computed, the confidence is determined against other IP

addresses returned for the geographic region being determined (*see paragraphs 0047, 0049, 136-139*).

11. As per claims 7, 13 and 17, McGuire et al teach a method of content authoring site for setting one or more geographic usage conditions for advertisement to be sent along with content (*see abstract, figs 1-5*), the method comprising receiving a geographic region for presenting advertisement associated with content (*see fig 24, paragraphs 0051-0053*) setting on or more conditions for the advertisement associated with the digital content, wherein the conditions are selected from a group of conditions consisting of a time period when the advertisement is presented (*see fig 24, paragraphs 0051-0053*), the number of times the advertisement is presented, whether the printing of coupons and other offers is permitted, and whether the sending of advertisement from the end user device receiving the advertisement to another end user device is permitted (*see paragraphs 0047, 0049, 136-139*); determining a credit card clearing address of the end user using an address verification system, wherein an end user sends a request via the end user device for the delivery of encrypted digital content (*see paragraphs 0047, 0049, 136-139*); and associating one or more pieces of advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*). McGuire et al fail to teach an inventive concept wherein a user requests the delivery of encrypted digital content. However, Yamada et al teach an inventive concept wherein a user requests the delivery of encrypted digital content (*see paragraphs 0015, 0040, 0051, 0117*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McGuire et al's inventive concept to include Yamada

Art Unit: 3621

et al's concept wherein a user request the delivery of encrypted digital content because this would have provided a method/system to specify each user who is entitled to the service the provider intends to provide, and prevent eavesdroppers from connecting themselves to the information transmission path and stealing service information (information steal protection)..

12. As per claims 8 and 9, McGuire et al teach a method of an online store to target advertisement to be sent along with content (*see abstract, figs 1-5*), the method comprising the steps of: determining an IP address of an end user device requesting delivery of the content by performing querying one or more IP addresses in IP databases provided by third parties (*see abstract, figs 1-5*); checking one or more country codes found in the trace routes to the IP address being determined, (*see paragraphs 0047, 0049, 136-139*) and using preassigned country allocations for class C IP addresses; and associating one or more pieces of advertisement with the encrypted digital content if the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*). (*see paragraphs 0047, 0049, 136-139*). McGuire et al fail to teach an inventive concept wherein a user requests the delivery of encrypted digital content. However, Yamada et al teach an inventive concept wherein a user requests the delivery of encrypted digital content (*see paragraphs 0015, 0040, 0051, 0117*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McGuire et al's inventive concept to include Yamada et al's concept wherein a user request the delivery of encrypted digital content because this would have provided a method/system to specify each user who is entitled to the service the provider intends

to provide, and prevent eavesdroppers from connecting themselves to the information transmission path and stealing service information (information steal protection).

13. As per claims 10, McGuire et al teach a method wherein the programming instruction of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the IP address of the end user device returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0047, 0049, 136-139*).

14. As per claims 11, McGuire et al teach a method wherein further comprising the instruction of: determining a credit card clearing address of the end user using an address verification system, wherein an end user sends a request via the end user device for the delivery of encrypted digital content; and wherein the programming instruction of determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the programming instruction of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the IP address is in a predetermined geographic region or if the address verification system returns an the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*)

Art Unit: 3621

15. As per claims 12, McGuire et al teach a method wherein. The computer readable medium of claim 9, further comprising the instruction of: determining a credit card clearing address of the end user using an address verification system, wherein an end user sends a request via the end user device for the delivery of encrypted digital content; and wherein the programming instruction of determining an IP address of the end user device requesting delivery of the encrypted digital content, and wherein the programming instruction of associating the one or more pieces of advertisement includes associating advertisement with the encrypted digital content if the IP address is in a predetermined geographic region and if the address verification system returns an the IP address of the end user device is in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*).

16. As per claims 14, McGuire et al teach an information processing system for hosting an online store to target advertisement to be sent along with encrypted digital content, the system comprising: an network interface to couple at least one end user device, wherein the end user device requests delivery of encrypted digital content; an address verification system including a means for determining an IP address of the end user device requesting the delivery of encrypted digital content, the address verification system including a mean for querying the IP address of the end user device; and means for associating one or more pieces of advertisement with the encrypted digital content if the address verification system returns an address in a predetermined geographic region (*see paragraphs 0047, 0049, 136-139*).

Art Unit: 3621

17. As per claims 15, McGuire et al teach an information processing system includes associating advertisement with the encrypted digital content if the IP address of the end user device returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0047, 0049, 136-139*).

18. As per claims 16, McGuire et al teach an information processing system includes associating advertisement with the encrypted digital content if the IP address of the end user device returns an address in a predetermined geographic region and one or more usage conditions for the encrypted digital content authorizes the advertisement to be associated with the geographical region of the end user device requesting the encrypted digital content (*see paragraphs 0047, 0049, 136-139*).

Conclusion

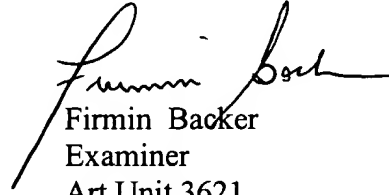
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer
Examiner
Art Unit 3621

November 13, 2003